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10/848,900	05/19/2004	Lowell D. Palecek	RA 5602 (33012/380/101)	6038
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TRUONG, THANHNGA B				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/848,900

**Applicant(s)**

PALECEK, LOWELL D.

**Examiner**

Thanhnga B. Truong

**Art Unit**

2435

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 September 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-6 and 8-21 is/are rejected.  
7) ☒ Claim(s) 7 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to the communication filed on September 11, 2008. Claims 1-21 are pending. At this time, claims 1-21 are still rejected.

#### ***Response to Arguments***

2. Applicant's arguments filed September 11, 2008 under **35 USC § 103** have been fully considered but they are not persuasive. However, upon an in-depth reviewed and further consideration of the claimed language and the specification, a new ground(s) of rejection is made further in view of Scheifler (US 6,282,652 B1).

Applicant's arguments filed February 19, 2008, with respect to the rejection(s) of claim(s) 1-4, 6-8, 11-13, and 16-21 under **35 USC § 101** have been fully considered and they are partially persuasive. Claims 11-13 are still not persuasive.

Referring to claim 11, although applicant has overcome the non-statutory rejection for claims 1 and 6, it is unclear to the examiner that claim 11 with the mean-plus-function is statutory. According to the specification the step of generating a service request requiring security function comes from client application (see specification, page 3, lines 17-19), which is a software module. Furthermore, how one could honoring said service request. The entire specification merely describes this "honoring" process. As a reminder to the applicant, that a software unit or module or application is not patentable.

Thus, claim 11 is non-statutory subject matter. Claims 12-13 are depended on claim 11, therefore they are also non-statutory subject matter.

Furthermore, applicant has argued that the allegation that "these claims have limitations that are similar" appears to create a new standard which is not supported in controlling law. Perhaps most significant is that claims 11-20 have standards of patentability which are different as a matter of law. For example, claims ii-15 employ "means-plus-function" limitations which must be examined under MPEP 2181-2184. The Examiner has not done so. Thus, the rejection of claims 11-20 is respectfully traversed for failure of the Examiner to actually examine the claims. Again, it is as reminder to the applicant and/or applicant's representative that claim 11 is a

broader version of claim 6, in which examiner has thoroughly examined it. If a narrow claim has fully rejected, it is obvious that the broader claim has also completely been covered by the narrow claim. Therefore, the rejection for claims 11-15 is efficient and proper.

The fact that Examiner may not have specifically responded to any particular arguments made by Applicant and Applicant's Representative, should not be construed as indicating Examiner's agreement therewith.

For the above reasons, it is believed that the rejections under 35 USC 101 should be sustained. Since examiner recognizes there are still some issues with 35 USC 101 and brings in a new prior art, this office action is a non-final.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 11-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

a. *Referring to claim 11:*

(1) Claim 11 recites An apparatus comprising: a. means for generating a service request requiring security functions including a user terminal computer; b. means responsively coupled to said generating means for honoring said service request while providing said security functions including a computer other than said user terminal computer; and c. means responsively coupled to said honoring means for embedding a security facility within a communication class library which provides said security functions. It does not contain a concrete system and would be considered non-statutory. According to the specification the step of generating a service request requiring security function comes from client application (see specification, page 3, lines 17-19), which is a software module. Furthermore, from a technical point of view, how one could carry out the step/process of honoring said service request. The entire specification merely describes this "honoring" process. As

a reminder to the applicant, that a software unit or module or application is not patentable. It is clearly that the client application and server application are software programs that are being used as programs, wherein these intangible media such as software or other program incapable of being touched or perceived absent the tangible medium through which they are conveyed. Thus, claim 1 does not recite any structure, i.e., machine to carry out the functions of all the recited steps. Therefore, claim 11 recites non-statutory subject matter. Claims 12-15 depend on claim 11, therefore they are rejected with the same rationale applied against claim 11 above.

***Claim Rejections - 35 USC § 112***

5 The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 11-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites an apparatus comprising: a. means for generating a service request requiring security functions including a user terminal computer; b. means responsively coupled to said generating means for honoring said service request while providing said security functions including a computer other than said user terminal computer; and c. means responsively coupled to said honoring means for embedding a security facility within a communication class library which provides said security functions. It is unclear to the examiner, from a technical point of view, how one could carry out the step/process of honoring said service request. The entire specification merely describes this "honoring" process. Appropriate correction is required.

Claims 12-15 depend on claim 11, therefore they are rejected with the same rationale applied against claim 11 above.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 6, 8-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung et al (US 6,012,090), and further in view of Scheffler (US 6,282,652 B1).

a. Referring to claim 1:

i. Chung teaches an apparatus comprising:

(1) a client application which generates a service request  
**(column 4, lines 21-25 of Chung);**

(2) a service application responsively coupled to said client application which responds to said service request **(column 4, lines 25-29 of Chung);**

(3) a communication class library which regulates communication between said client application and said service application **(see Figure 1 of Chung);**

(4) a security facility embedded within said communication class library **(column 5, lines 19-27; column 11, lines 22-28 of Chung);** and

(5) wherein said security facility is automatically activated by said service request **(column 11, lines 22-31 of Chung).**

ii. Although Chung teaches an apparatus for improving the efficiency of service request activity requiring security function in which registration applets may be written in the Java language and embedded in the HTML code of corresponding portions, or pages, of the browser program **(column 5, lines 24-26 of Chung)**, Chung is silent on the capability of using a communication class library which regulates communication between said client application and said service application.

On the other hand, Scheifler teaches this limitation in **column 4, lines 60-64 of Scheifler**.

iii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

(1) have modified the invention of Chung with the teaching of Scheifler for the server to designate a separate set of communication requirements for each method invoked on behalf of a client or another server (**column 4, lines 55-57 of Scheifler**).

iv. The ordinary skilled person would have been motivated to:

(1) have modified the invention of Chung with the teaching of Scheifler to improvement over conventional systems by permitting a server to designate communication requirements on a per-method basis (**column 4, lines 53-54 of Scheifler**).

b. Referring to claim 6:

i. Chung teaches a method of handling a service request from a client application to a service application comprising:

(1) embedding a security facility within a communication class library (**column 5, lines 19-27; column 11, lines 22-28 of Chung**);

(2) generating a service request within said client application (**column 4, lines 21-25 of Chung**);

(3) transferring said service request from said client application to said service application (**see Figure 1 of Chung**);

(4) receiving said service request by said service application (**see Figure 1 of Chung**);

(5) honoring said service request by said service application (**column 4, lines 25-29 of Chung**); and

(6) automatically implementing security functions from said embedded security facility during said step which honors said service request (**column 5, lines 19-27; column 11, lines 22-28; column 4, lines 25-29 of Chung**).

ii. Although Chung teaches an apparatus for improving the efficiency of service request activity requiring security function in which registration applets may be written in the Java language and embedded in the HTML code of corresponding portions, or pages, of the browser program (**column 5, lines 24-26 of Chung**), Chung is silent on the capability of using a communication class library which regulates communication between said client application and said service application. On the other hand, Scheifler teaches this limitation in **column 4, lines 60-64 of Scheifler**.

iii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

(1) have modified the invention of Chung with the teaching of Scheifler for the server to designate a separate set of communication requirements for each method invoked on behalf of a client or another server (**column 4, lines 55-57 of Scheifler**).

iv. The ordinary skilled person would have been motivated to:

(1) have modified the invention of Chung with the teaching of Scheifler to improvement over conventional systems by permitting a server to designate communication requirements on a per-method basis (**column 4, lines 53-54 of Scheifler**).

c. Referring to claim 8:

i. The combination of teaching between Chung and Scheifler teaches the claimed subject matter. Chung further teaches:

(1) wherein said transferring step further comprises transferring said service request to said service application via a publically accessible digital data communication network (**see Figure 1 of Chung**).

d. Referring to claim 9:

i. The combination of teaching between Chung and Scheifler teaches the claimed subject matter. Chung further teaches:

(1) further comprising a user terminal wherein said client application is located within said user terminal (**see Figure 1 of Chung**).



e. Referring to claim 10:

i. The combination of teaching between Chung and Scheifler teaches the claimed subject matter. Chung further teaches:

(1) further comprising a data base management system wherein said service application is located within said data base management system **(see Figure 1 of Chung).**

f. Referring to claims 11-20:

i. These claims have limitations that are similar to those of claims 6-10, thus they are rejected with the same rationale applied against claims 6, 8-10 above.

9. Claims 2-5, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung et al (US 6,012,090), in view of Scheifler (US 6,282,652), and further in view of Herman et al (US 6,341,353 B1).

a. Referring to claims 2, 4:

i. The combination of teaching between Chung and Scheifler teaches the claimed subject matter. Although they both teach the security services, they are silent on the capability of using encryption/decryption objects in their security services. On the other hand, Herman teaches this limitation in **column 18, lines 45-47 of Herman.**

iii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

(1) have modified the modified-invention of Chung with the teaching of Herman so that data is not visible to any but an authorized user/owner. **(column 18, lines 36-37 of Herman).**

iv. The ordinary skilled person would have been motivated to:

(1) have modified the modified-invention of Chung with the teaching of Herman so that two parties who do not trust each other can each determine that the other entity is who it claims to be. This is accomplished with authenticating protocols that may employ encryption, hashing, digital signatures, etc **(column 18, lines 41-44 of Herman).**

b. Referring to claim 3:

i. The combination of teaching between Chung, Scheifler, and Herman teaches the claimed subject matter. Scheifler further teaches:

(1) wherein said security facility further comprises security support provider interface (**column 11, line 60 through line 7 of Scheifler**).

c. Referring to claim 5:

i. The combination of teaching between Chung, Scheifler, and Herman teaches the claimed subject matter. Herman further teaches:

(1) further comprising a user terminal responsively coupled to a data base management system via a publically accessible digital data communication network and wherein said client application is located within said user terminal and said service application is located within said data base management system (**see Figure 1 of Chung; Figure 1 of Herman**).

d. Referring to claim 21:

i. This claim has limitations that are similar to those of claims 1-5, thus it is rejected with the same rationale applied against claims 1-5 above.

***Allowable Subject Matter***

10. Claim 7 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanhnga (Tanya) Truong whose telephone number is 571-272-3858.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached at 571-272-3859. The fax and

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phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

/Thanhnga B. Truong/

Primary Examiner, Art Unit 2135

TBT

December 7, 2008